

REMARKS

In accordance with the foregoing, no new matter is being presented, and approval and entry are respectfully requested.

Claims 11-43 are pending and under consideration.

REJECTION UNDER DOUBLE PATENTING:

Claims 11-43 are pending and under consideration. Please find enclosed a copy of a Terminal Disclaimer to address, without prejudice, the Examiner's provisional rejections of the claims under the judicially created doctrine of obviousness-type double patenting. In view of the enclosed Terminal Disclaimer, it is respectfully requested that the Examiner reconsider and withdraw the provisional rejection of claims 11-43.

REJECTION UNDER 35 U.S.C. § 102:

In the Office Action, at page 28, claims 11-12, 15-27, 39, and 41 were rejected under 35 U.S.C. § 102 in view of EP 0 833 337 A2 to Aramaki et al. ("Aramaki"). This rejection is traversed and reconsideration is requested.

Aramaki generally describes an editing method for **deleting a prescribed section** of a program and editing apparatus thereof. Emphasis added. See abstract of Aramaki. A **recording time** of programs is recorded using 6 bytes, where two bytes are taken for the manufacturers code and a model code showing the manufacturer of the recording apparatus used for recording the program. However, nothing in Aramaki teaches or suggests that any of the bytes includes manufacturer information including "recording an identification information of a manufacturer of a recording apparatus that **recorded or modified** the content of the recording medium different from the identification information **prior to** the recording or the modification," emphasis added, as recited in independent claim 11. Rather, Aramaki simply stores the code of the manufacturer of the recording apparatus, not of the manufacturer "that recorded or modified the content of the recording medium different from the identification information prior to the recording or the modification," as recited in independent claim 11.

According to Aramaki, the user determines whether a point designated for an end point designation operation DE is appropriate. See column 31, lines 7-12 of Aramaki. A system controller 11 then updates U-TOC data from a section delete start address Ads to a section delete end address Ade **to be deleted** based on the section delete start address Ads and the

section delete end address Ade. Emphasis added. See column 31, lines 13-21 of Aramaki. The updated U-TOC data is transferred as recording data and a U-TOC area of disc 1 is carried out. When the updating processing is complete, the section delete is complete. See column 31, lines 22-25 of Aramaki.

However, contrary to the assertions made in the Office Action, Aramaki fails to teach or suggest, "recording an identification information of a manufacturer of a recording apparatus that **recorded or modified** the content of the recording medium **different** from the identification information **prior to** the recording or the modification," emphasis added, as recited in independent claim 11. Rather, Aramaki limits its description to designating a start point and an end point of the section to be deleted and linking the programs preceding and proceeding the erased portion. The cited reference fails to teach or suggest all the claimed features recited in independent claim 11.

Furthermore, the Office Action refers to similar portions of the cited references to reject independent claim 15 as the portions of the cited references previously discussed and distinguished from the claimed features of independent claim 11. The arguments presented above supporting the patentability of independent claim 11 in view of Aramaki are incorporated herein to support the patentability of independent claim 15. Accordingly, Aramaki fails to teach or suggest all the claimed features of independent claims 11 and 15. It is respectfully requested that independent claims 11 and 15 and related dependent claims be allowed.

REJECTION UNDER 35 U.S.C. § 103:

In the Office Action, at page 32, claims 13-14, 28-38, 40, and 42-43 were rejected under 35 U.S.C. § 103 in view of Aramaki in view of U.S. Patent No. 6,038,366 to Ohno et al. ("Ohno"). This rejection is traversed and reconsideration is requested.

Because claims 14 and 40 depend from independent claim 13, claims 29, 30, and 42 depend from independent claim 28 and claims 32-38 and 43 depend from independent claim 31, the cited references, individually or combined, must teach or suggest all the claimed features recited in independent claims 13, 28, and 31.

Independent claim 13 recites, "the identification information of the manufacturer is different from the identification information prior to the recording or the modification," and independent claim 28 recites, "a recording and reproducing apparatus indicating a manufacturer of the recording and reproducing apparatus that recorded or modified the content of the recording medium different from the manufacturer identification information prior to the

recording or the modification." Further, independent claim 31 recites, "an apparatus that recorded or modified the content of the recording medium different from the manufacturer identification information prior to the recording or the modification." The Office Action refers to similar portions of Aramaki to reject independent claims 13, 28, and 31 as the portions of the cited reference previously discussed and distinguished from the claimed features of independent claims 11 and 15. The arguments presented above supporting the patentability of independent claims 11 and 15 in view of Aramaki are incorporated herein to support the patentability of independent claims 13, 28, and 31.

Ohno generally provides a magnetic recording/reproducing apparatus, which can facilitate search of programs recorded on a magnetic tape. See column 2, lines 14-20 of Ohno. The apparatus checks whether a VTR manufacturer number data as fetched from the tape coincides with the VTR manufacturer number stored in a library memory 4. See column 6, lines 25-31 of Ohno. However, rather than teaching or suggesting that the apparatus records or modifies "the content of the recording medium and a **manufacturer identification information** of the recording/reproducing apparatus to determine whether a manufacturer specific information of the recording/reproducing apparatus is effective, wherein the identification information of the manufacturer is **different from the identification information prior to the recording or the modification**," emphasis added, as recited in independent claim 13, in Ohno, unless coincidence is found, a control processing is **terminated** by regarding the tape as loaded is not the one of concern. Emphasis added.

Referring to independent claim 13, according to the Office Action, column 6 of Ohno, lines 18-31, teaches the claimed features of independent claim 13. The referred portion of Ohno describes a control procedure where a preliminary play-back operation is carried out to read out tape map information recorded in a video signal. Specifically, the control procedure checks whether the VTR manufacturer number data as fetched from the tape coincides with the VTR manufacturer number stored in the library memory 4 shown in FIG. 1. Unless coincidence is found, this control processing is terminated. The tape map information, as described by Ohno, concerns the contents of program(s) recorded on the loaded tape, temporal duration(s) of the program(s), and history of play-back of the tape. See abstract.

However, the tape map information does not include "an identification code of a manufacturer of a device which last modified the content of the recording medium," as recited in independent claim 13. Nowhere in the referred portion of Ohno, or anywhere else in the reference, is there a teaching or suggestion of the claimed features of independent claim 13. Specifically, Ohno fails to teach or suggest "verifying a coincidence of an identification code of a

manufacturer of a device which last modified the content of the recording medium and the manufacturer identification code of the recording/reproducing apparatus to determine whether manufacturer specific information of the recording/reproducing apparatus is effective," as recited in independent claim 13.

Similarly to Aramaki, Ohno does not teach or suggest, "a recording and reproducing apparatus indicating a manufacturer of the recording and reproducing apparatus that recorded or modified the content of the recording medium different from the manufacturer identification information prior to the recording or the modification; and reading a manufacturer identification information, determining whether the content is effective based upon whether the read manufacturer identification information matches that of the recording and reproducing apparatus, and reading the content if the content is effective," as recited in independent claim 28, and "reading the manufacturer identification information of a manufacturer of an apparatus that recorded or modified the content of the recording medium different from the manufacturer identification information prior to the recording or the modification; and determining whether to read the content based upon the read manufacturer identification information," as recited in independent claim 31. Rather, Ohno recognizes that the problem of erroneous recognition of a tape can satisfactorily be coped with by using as tape identification information the manufacture number (i.e., the VTR manufacture number) of the magnetic recording/reproducing apparatus that was used for recording programs on the tape. See column 2, lines 30-37. Accordingly, Aramaki and Ohno, individually or combined, fail to teach or suggest all the claimed features of independent claims 13, 28, and 31 and related dependent claims. It is respectfully asserted that independent claims 13, 28, and 31 and related dependent claims are allowable in view of the prior art of record.

Furthermore, as commonly understood, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992).

Nonetheless, the Office Action has provided absolutely no motivation to combine the cited references. Rather, conclusive statements are made such as that "it would have been obvious to an artisan of ordinary skill in the art to incorporate the capabilities of comparing the VTR manufacturer number data recorded on the tape and VTR manufacture number stored in the library memory ... in order to facilitate search of programs recorded on recording medium, indexing of heading portion of the programs and display of teletext or closed caption and the

like without essentially incurring additional manufacturing cost of the apparatus." Applicants respectfully assert that the Office Action has failed to establish the *prima facie* case of obviousness based upon the prior art and has failed to present evidence pointing out in either reference where the recited motivation asserted in the Office Action can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

Assuming, *arguendo*, that the description of Ohno and Aramaki would be combined, the combination would provide an editing method for deleting a section of a program by designating a start point and an end point of the section to be deleted and linking the programs preceding and proceeding the erased portion, where if the VTR manufacturer data does not coincide with the VTR manufacturer number stored in the memory, the deletion would be terminated by regarding the tape as loaded as not the one of concern. Such combination fails to teach or suggest all the claimed features of independent claims 13, 28, and 31.

"Rejection of patent application for obviousness under 35 USC §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record."

See In re Lee 61 USPQ2d 1430 (CA FC 2002).

Thus, as pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

However, only the present invention sets forth all the claimed features, as well as the motivation for combining the same. The outstanding rejection would appear to have taken this teaching of the present invention and applied the same to generate a combination of Ohno and Aramaki, as set forth in the Office Action, to disclose the presently claimed invention. Applicants respectfully assert that the *prima facie* burden has not been met. It is respectfully requested that independent claims 4 and 25 and related dependent claims be allowed.

It is respectfully requested that independent claims 13, 28, and 31 and related dependent claims be allowed.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.

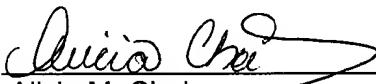
If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: 
Alicia M. Choi
Registration No. 46,621

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501